



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

10/563,007

04/20/2006

Antonio Macchi Cassia

1029.1030

1345

20311 7590 10/20/2008
LUCAS & MERCANTI, LLP
475 PARK AVENUE SOUTH
15TH FLOOR
NEW YORK, NY 10016

EXAMINER

ALIE, GHASSEM

ART UNIT

PAPER NUMBER

3724

MAIL DATE

DELIVERY MODE

10/20/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/563,007	Applicant(s) CASSIA, ANTONIO MACCHI	
	Examiner GHASSEM ALIE	Art Unit 3724	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07/09/08.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-6 and 8-17 is/are pending in the application.
- 4a) Of the above claim(s) 5,6 and 8-17 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 12/28/08 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Election/Restrictions

1. Newly submitted claims 5-6 and 8-17 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: claim 1-3 which have originally presented and examined and newly submitted and amended claims 5-6 and 8-17 do not relate to a single inventive concept. It should be noted that the dependent claims 5-6 and 8-10 are also considered as new claims, since they were not considered in the original Office action.

Group I, claim 3, drawn to a dispensing device including means for retaining a starting tip of a spare roll having a rubber panel with a cross-shaped cut.

Group II, claims 5, 12, 14 and 16, drawn to a dispensing device including means for the top hinging of the cover having teeth formed at the top of the base.

Group III, claims 6, 13 and 17, drawn to a dispensing device including means suitable

to turn a push on the cover into a driving impulse having a pair of rocker arms.

Group VI, claims 8-11 and 15, drawn to a dispensing device including a cover having an inclined plane integrally projecting downward at the area of nipping of the paper.

It should also be noted that claim 1 links invention I-IV. The restriction requirement among the linked inventions is **subject to** the nonallowance of the linking claim(s) 1. Upon the indication of allowability of the linking claim(s), the restriction requirement as to the linked inventions **shall** be withdrawn and any claim(s) depending from or otherwise requiring all the limitations of the allowable linking claim(s) will be rejoined and fully examined for patentability in accordance with 37 CFR 1.104.

2. The inventions listed as Groups or Inventions I-IV do not relate to a single inventive

Art Unit: 3724

concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special features for the following reasons: The technical feature of the invention I, as mentioned above, is not present in inventions II-IV. Conversely, the technical features in inventions II-IV are not present in invention I. It should be noted that inventions I-IV are distinct from one another by having at least a specific feature that is not presented in the other inventions.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 5-6 and 8-17 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

Specification

3. The specification is objected to under 37 CFR 1.71 because it fails to teach how the pre-established length of the paper is cut. The specification fails to teach first and second blades or a cutting unit. The specification fails to teach how the cutting unit work with the parts of the dispensing device to cut a length of the paper.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Art Unit: 3724

5. Claims 1-6 and 8-17 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Regarding claim 1, the specification fails to teach how “a pre-established length of band” or the paper is cut. The specification fails to teach a cutting unit or first and second blades. The specification fails to teach how the first and second blade works with the parts of the dispensing device to cut a length of the paper.

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claims 1-6 and 8-17 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Regarding claim 1, "a band feeding and cutting unit configured to control feeding of a pre-established length of band and cutting of said pre-established length of band through a pull exerted by a user on a tip of paper (C) projecting from the device” is not clear. It is not clear what type of band feeding and cutting unit is claimed. It is not clear what encompasses the band feeding and cutting unit.

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claim 1-4, as best understood, are rejected under 35 U.S.C. 103(a) as being unpatentable over Granger (6,006,642) in view of Morand (4,846,412). Regarding claim 1, Granger teaches a dispensing device for paper sheets cut from a continuous band wound up in a roll RS comprising a case 1 including a base and a cover 2, the cover being provided with a bottom opening as paper outlet,. Granger also teaches a mechanism for automatically replacing the finished roll with a spare roll RR, a band feeding and cutting unit 5 configured to control feeding of a pre-established length of band and cutting of the pre-established length of band through a pull exerted by a user on a tip of paper projecting from the device. Granger also teaches means for retaining the starting tip of said spare roll, means for the top hinging of said cover to said base. Se Figs. 1-5 and col. 5, lines 1-64 in Granger. Granger does not explicitly teach connection means suitable to turn a push on the cover into a driving impulse for said feeding and cutting unit. However, Morand teaches connection means 60 suitable to turn a push on a cover 80 into a driving impulse for said feeding and cutting unit. See Figs. 1-5 in Morand. It should be noted that pressure on the connection means 60 also exert some pressure on the cover 80. It would have been obvious to a person of ordinary skill in the art to provide Granger's dispenser device with the connection means, as taught by Morand, in order to manually feed the paper in an alternative manner that facilitates dispensing of the paper from the dispenser device.

Regarding claim 2, Granger teaches everything noted above including that the mechanism for automatically replacing the finished roll RS including a frame rotatably mounted on a frame of the feeding and cutting unit, the frame of the replacement mechanism has an inside in which a first pivot that carries a pair of independent arms carrying

Art Unit: 3724

respectively the first roll and the spare roll, on the same internal side of the frame there being provided a second more advanced pivot that carries a plate on which there is formed a cam shaped with a horizontal top portion and a rear vertical portion connected by a substantially curved front portion, each of the arms being provided with a relevant peg positioned so that it can follow the profile of the cam. See Figs. 1-5 in Granger.

Regarding claims 3-4, Granger, as modified above, does not explicitly teach that the means for retaining the starting tip of the spare roll RR consist of a rubber panel with a cross-shaped cut. However, Official Notice is taken that the use of a rubber panel with a cross-shaped cut for retaining the tip of a roll is well known in the art.

10. Claim 1, as best understood, are rejected under 35 U.S.C. 103(a) as being unpatentable over Morand in view of Granger. Regarding claim 1, Morand teaches a dispensing device for paper sheets cut from a continuous band wound up in a roll 18 comprising a case 12 including a base 16 and a cover 80, the cover being provided with a bottom opening as paper outlet. Morand also teaches a mechanism for automatically replacing a finished roll with a spare roll 40, a band feeding 20 and cutting unit configured to control feeding of a pre-established length of the band and cutting of the pre-established length through a pull exerted by a user on a tip of paper projecting from the device. Morand also teaches means for retaining the starting tip of said spare roll, means for the top hinging of said cover to said base. See Figs. 1-6 in Morand. Morand does not teach that the band feed roller is also a cutting roller. However, the use of a feeding and cutting type roller is dispenser devices are well known in the art such as taught by Granger. See Figs. 1-6 in Granger. It would have been obvious to a person of ordinary skill in the art to provide

Art Unit: 3724

Morand's dispenser device with the feeding and cutting roller, as taught by Granger, in order to feed and cut the paper with the same roller.

Response to Amendment

11. Applicant's arguments filed on 07/09/08 have been fully considered but they are not persuasive.

Applicant's argument that the cutting unit is disclosed in various European patents including application EP 930039 is not persuasive. It is not clear how the cutting unit such as the cutting unit in the EP 930039 works with other parts of the invention to cut a pre-established length of band. It is not clear where the cutting unit is located. It is also not clear how the cutting unit is connected to the other parts of the dispenser in the instant invention and how does it work with the other parts of the invention to cut a pre-established length of band.

Applicant's states that it is not understood which elements of Granger the Examiner has cited as means for retaining a starting tip (S) of said spare roll, and means for the top hinging of said cover to the base. Furthermore, applicant states that in the events that Examiner generates a second Office action with detailed guidance on which elements of Granger are being used to reject the claims, it is requested that the second Office action to be made non-Final. It is not understood, how further clarification of the rejection by Examiner upon the request of the applicant is consider to be a new ground of rejection. Applicant asserts that item b) means for retaining a starting tip (S) of said spare roll; and item c) means for the top hinging of said cover to the base are not specifically identified by the Examiner. Therefore, if Examiner identifies those items there will be a new ground of rejection. Firstly,

Art Unit: 3724

Granger teaches that the cover 2 is a hinged cover. See col. 3, lines 44-46. Fig. 1 in Granger, Granger also teaches that the cover 2 is hinged to the top wall of the base, as clearly shown in Fig. 2. In addition, any wall of the base that is hinged to the cover 2 is considered to be the top of the base, since neither the top of the base or the cover has been specifically identified in the claims or differentiated from the other sides of the base or the cover in the claims. Secondly, “means for retaining the starting tip of said spare roll” is a very broad limitation. Any item that supports or holds the starting tip of the spare roll is considered to be means for retaining the starting tip of the spare roll. In this case, the spare roll is identified by reference (RR) in Granger. See col. 7, lines 31-32. Any items that holds the spare roll also inherently retains the tip of the spare roll. There are many items in Granger’s dispenser that hold the spare roll as shown in Figs. 1-5 in Granger. Claim 1 does not even identifies general components of the means for retaining the tip of the spare roll. Claim 1 merely calls for “means for retaining the starting tip (S) of said spare roll (R’).”

Conclusion

12. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the

Art Unit: 3724

advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ghassem Alie whose telephone number is (571) 272-4501.

The examiner can normally be reached on Mon-Fri 8:30 am - 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Boyer Ashley can be reached on (571) 272-4502. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, SEE <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Ghassem Alie/

Primary Examiner, Art Unit 3724

October 10, 2008